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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22 (20031016)

Application Number: 09/243,237
Filing Date: February 02, 1999
Appellant(s): MUKHOPADHYAY, DEBASISH

DEBASISH MUKHOPADHYAY

For Appellant

EXAMINER'S ANSWER

MAILED
OCT 22 2003
GROUP 1700

This is in response to the appeal brief filed 7/04/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 37 and 38, and its dependent claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,766,479	Collentro et al.	6/1998
5,670,053	Collentro et al.	09/1997
5,645,727	Bhave et al	07/1997
5,573,662	Abe et al	11/1996
5,250,185	Tao et al.	10/1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 37-62 are rejected under 35 U.S.C. 103(a). This rejections are set forth in prior Office Action, Paper No. 18. Copy attached bellow.

(11) Response to Argument

The Examiner has considered applicant's arguments on the Appeal Brief filed on 7/14/2003, such arguments are not persuasive because they are directed to the process of producing or treating the water, and not to the water composition as a product itself. Regarding to Collentro's references '479 and '053, as applied to claims 39 and 44, the percentage of TOC with respect to the feed water stream, percentage removed in the process, is argued. The percentage of TOC in the feed water and in the final water is not recited in the claims. The claims have been examined considering the term "less than 0.34 % as the final TOC in the "product water" claimed. The same considerations have been made for claims directed to water with "silica", and "boron". Details of water composition of the prior art as compared to the water composition or product of the present inventions has been discussed in paper 18, which rejection is maintained,

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because Applicant fails to provide enough evidence of that the water produced by the process has a distinct composition than the water produced by the prior art of record.

The rejection is further maintained with based on cases law discussed in the final Office, which establish that "product by process claims are products". Bellow there is one of the cases cited in the referred section (2113) of the M.P.E.P. discussed in the final action.

In re Thorpe 964(1985.

In re Thorpe, et al.

No.85-1913

Decided November 21, 1985

1.Subject matter for patent monopoly-Process, product and apparatus (51.613)


Determination of patentability in "product by-process" claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is same as, or obvious from, product of prior art, even if prior product was made by different process.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


Ana M Fortuna
Primary Examiner
Art Unit 1723

Ana M. Fortuna
October 16, 2003

Conferees

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See attached copy of final Office Action on next page.

The Board also criticized appellant's survey, and the Board interpreted the survey results as showing that the remaining 16% to 25% of the consumers sampled "would have recognized BUNDT as the name of a type of cake rather than the Pillsbury cake mix brand." *Id.* 221 USPQ at 1115. Although we do not find support for the Board's reasoning on this point, we do agree with the Board that this survey does not demonstrate that the name BUNDT has lost its status as a common descriptive name. We believe the Board correctly held that appellant had not met its burden of rebutting the *prima facie* case that BUNDT is a common descriptive name.

The Board emphasized that the recipe in The Settlement Cook Book predates applicant's first use of the mark BUNDT on cake pans by at least twenty years, and that the recipes continued to appear in recent cookbooks of wide circulation. The various newspaper articles do not contradict the conclusion that BUNDT is known as the name of a type of cake, despite the retractions by some of the columnists. As the Board pointed out, "the significance of a generic term, especially in respect of foods, is clearly not restricted to the ethnic population from whose culture the term originated." *In re Northland Aluminum Products Inc.*, 221 USPQ at 1113 (footnote omitted).

Having affirmed the Board's conclusion that BUNDT is a common descriptive name, neither obsolete nor obscure, evidence of secondary meaning can not change the result. *G.D. Searle*, 360 F.2d at 656, 149 USPQ at 624; *Cummins Engine Co.*, 359 F.2d at 865, 149 USPQ at 561-62; *Weiss Noodle Co.*, 290 F.2d at 848, 129 USPQ at 414.

C.

[1] Appellant urges us to consider its disclaimer, which appellant described somewhat expansively (since the disclaimer refers only to coffee cake), as accomplishing the result "that the registration now being solicited will not embarrass anybody's right to make a cake, to call a cake, or indeed to label a cake which he, she or it has made as being a 'bundt' cake." *In re Northland Aluminum Products, Inc.*, 221 USPQ at 1113.

The Board criticized the disclaimer as "meaningless" because "its effect would have been to leave no part of the mark which is registrable." *Id.* (footnote omitted). We agree with the Board that it is not of trademark significance to differentiate a cake made from a cake mix from a cake made from a recipe. Appellant argues that Pillsbury's BUNDT cake mix does not follow the traditional BUNDT KUCHEN recipe; but the Board

observed that the cake is shown in the traditional bundt shape. If as appellant argues its use of the name BUNDT is not descriptive of BUNDT cake, then it is confusingly misdescriptive; in neither case is the statute complied with. *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 863, 132 USPQ 627, 634 (CCPA 1962) (immaterial that some of the so-called SUDSY ammonia products were not sudsy because they contained no detergent).

The Board also correctly found that the form of the lettering of the mark is "not so distinctive as to create a commercial impression separate and apart from the term BUNDT." *In re Northland Aluminum Products, Inc.*, 221 USPQ at 1113 n.9. The record is devoid of evidence of public recognition of this overall format as a trademark. *G.D. Searle*, 360 F.2d at 655-656, 149 USPQ at 623.

[2] On the totality of the evidence, we affirm the Board's decision that BUNDT is a common descriptive name for a type of ring cake, and is not registrable as a trademark for "ring cake mix."

AFFIRMED.

Court of Appeals, Federal Circuit

In re Thorpe, et al.

No. 85-1913

Decided November 21, 1985

PATENTS

1. Subject matter for patent monopoly — Process, product and apparatus (§51.613)

Determination of patentability in "product-by-process" claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is same as, or obvious from, product of prior art, even if prior product was made by different process.

2. Subject matter for patent monopoly — Process, product and apparatus (§51.613)

Patent and Trademark Office Board of Appeals did not err by affirming examiner's rejection of "product-by-process" claims, absent proof by applicant that prior art products do not necessarily or inherently possess characteristics of his claimed product.

Particular patents — Color Developers

Thorpe, et al., application, Improved Process for Metal-Modified Phenolic Novalac Resin, rejection of claims 44-47 affirmed.

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(1985)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/243,237	02/02/1999	DEBASISH MUKHOPADHYAY	MDO-2471-D1	2221

20793 7590 10/22/2003

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EXAMINER

FORTUNA, ANA M

ART UNIT	PAPER NUMBER
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1723

22

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 37-41, 41, 55, 56, are rejected under 35 U.S.C. 103(a) as being unpatentable over Collentro et al.(5,766,479 , 5,670,053). Reference '479 discloses a process treating water having the components claimed in step a), the process includes removal of hardness ions, dissolved gas, e.g. CO₂, and more than one reverse osmosis treatment stages or passes (abstract, column 5, lines 20-68, column 6, lines 55). The product obtained by the process of '479 in a first RO membrane treatment contains ionized material, e.g. silica between 0-20 ppm, and TOC is substantially removed by pretreatment, e.g. activated carbon and nanofiltration, which removes organic matter (column 5, last paragraph, and column 6, first paragraph), further removal is expected by the reverse osmosis stages treatment, the low degree of TOC can be evidence by the level of **resistivity in the ultrapure water, e.g. 10 megohm-cm** can be produced, therefore, the water produced in the second stage meets the requirement of TOC levels claimed. Reference '479 fails to disclose the process steps in the order and conditions claimed in the present

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invention, but the products meets the conditions of the product water or treated water as claimed including the TOC and silica levels. Reference '053 also discloses water product with the claimed TOC level, e.g. , 1 to about 5 ppm (column 8, lines 26-31, column 9, lines 24-40, column 10, lines 34-37); the source of water to be treated is also disclosed (column 5, lines 41-61). removing ionic material in a first reverse osmosis stage up to 95 % is disclosed (column 6, lines 55-65), and removal of 90 % of the remaining ions in the second reverse osmosis membrane (column 9, lines 1-17) therefore, removal of silica as claimed should have been expected to the skilled in the art. Reference '053 fails to disclosed the process including all the conditions of the claimed process of making the product water, however, teaches the product water with properties., e.g TOC and silica or ionized species level claimed, the degree of purity measured as resistivity greater than 1 also indicates the degree of purity of the produced water in the references above. Regarding claims 29 and 33 water free of virus and bacteria is produced, e.g. water meeting the USP standards (column 9, lines 24-39).

3. Claims 37-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhawe et al. (5,645,727). Reference '727 discloses the product "water" having the TOC, Silica, Boron, bacteria levels claimed (Tables II and III), virus removal is not disclosed, but since the process remove pyrogen and bacteria by reverse osmosis and other polishing steps, virus is also expected to be remove. Reference '727 fails to disclose the process steps for producing water, but discloses the water with the claimed purity. Since product by process claims are product, the rejection is proper. Water product having a resistivity (degree of purity of the ultrapure water)

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of 18.2 M ohm/cm at 25 degree C is also disclosed (Table II, column 17), the boron, TOC and silica of the produced water is also disclosed (column 15, lines 23-34, column 16, lines 1-34, and Table III, column 17, lines 1-44).

4. Claims 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe et al. (5,573,662).

Reference '662 discloses product water with the level of TOC as in the product of the claims above (column 7, Table). The process including the claimed steps for producing the water are not disclosed, however, treating the water by reverse osmosis unit, which removes alkalinity and hardness ions, vacuum deaeration to remove gases, ion exchange, and ultraviolet as water refining steps are disclosed. Therefore, although the process including pH adjustment is not disclosed, producing water having the TOC level claimed is disclosed by '662 (column 3, lines 53).

Additional removal of other contaminants should have been expected by the skilled in the art at the time the invention was made based on the membrane treatment and posttreatment of the water.

5. Claims 37-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tao et al. (5,250,185). Reference '185 discloses a product water containing 1.2 % of boron (column 7, lines 38-47). The process for producing the product water includes pretreatment, reverse osmosis, pH adjustment prior the reverse osmosis, sodium, calcium, silica sulfate carbonate and TOC are also remove by the process (table I, columns 7-8). It would have been obvious to ne skilled in the pertinent art to produce water with he same quality by treating the water at the same

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pH and by reverse osmosis as suggested by '185. Reference '185 discloses a substantial removal of contaminants from the feed water, including high TOC, silica, boron, alkalinity and hardness ions. Producing water of higher purity should have been obvious to one skilled in the art at the time the invention was made, e.g. by duplicating the process (providing additional membranes).

Response to Amendment

5. **Response to Applicant's Remarks:** the discussion below respond to arguments in paper No.16, filed on 4/24/02).

With respect of arguments about Collentro 's references , claims 37 and 38 are only directed to a "low solute containing water", which limitation is met by reference '479, which produces water with a resistivity of 10 megohm-cm. Regarding the TOC content of the water product, this is also met by the degree of purity of the water produced by '479; '479 discloses removing organic matter (causing TOC), by pretreatment with nanofiltration and activated carbon(column 6, lines 10-47), the NF having pore size as low as 0.008 micron, and the total pretreatment produces a water to be treated in the first reverse osmosis membrane having a total dissolved solids as low as 4.5 ppm, since total organic carbon is part of the total organic solid content in the water, it would have been obvious to one skilled in the art at the time the invention was made to expect the final water produced from the last RO stage to have TOC levels within the levels claimed by Applicant.

Reference '053 also teaches the bacteria and TOC levels claimed, where a total organic carbon of less than 500 ppb is disclosed (column 9, lines 24-39). A total dissolved solids in the range of 0-

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300 ppm in the product water is also disclosed (column 10, lines 34-37), for a resistivity of 2-4 megohm. Therefore, the TOC level in water with higher degree of purity, e.g. 10 megohm, as in '479 should be less than 500 ppb, which is lower than the claimed values in present application.

In response to arguments directed to the rate of removal of the different impurities by the process producing the claimed **water** product, the ways of determining allowability of a product by process claims is discussed in the MPEP, section 2113 related case law are also discussed, and are attached.

Product by process claims are products.

The invention defined by a product-by-process claims IS a product, NOT a process. In re Bridgeford, 357 F2d 679; 149 USPQ 55 (CCPA 1996). It is the patentability of the product claimed and NOT of the recited process steps which must be established. In re Brown, 459 F2d 531; 173 USPQ 685 (CCPA 1976). A comparison of the recited process steps with the prior art processes does NOT serve to result the issue concerning the patentability of the product. In re Fessman, 489 F2d 742; 180 USPQ 324 (CCPA 1974).

Applicant argues that Bhavé et al does not teach the percentages with respect to the feed water; the claims in the present invention are directed to "product water with low solute", and only the percentage of TOC, Boron, silica, etc. are claimed as part of the process or producing the product and its removal rate and not as final composition that distinguish from the prior art of record. ion. As mention in the case law above, the process step, in this particular case does not define the

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product, and the product, having the same properties can be made by other processes, as disclosed in the prior art of record discussed above.

The same arguments with respect to Caloundra's references and Bhavé et al, applied to references to Abe and Tao respectively. The rejections are maintained, Applicant fails to provide concrete evidence of an unobvious difference between the product claimed in the present invention and the product of the above discussed references. Applicant fails to show, for example that water having the resistivity disclosed in Caloundra's references, and in Bhavé et al (10 and 18.2 respectively) are inferior in the components claimed in the water (product) claimed in the present invention. Furthermore, Applicant discloses producing water with a resistivity of 18.2 megaohm-cm (page 56, lines 33-26), in which additional process steps are required to reach such high level of purity (which is not claimed).

6. References on IDS of 4/24/02 have been considered by the Examiner. A signed copy of Form-1449 is attached.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for regular responses, and (703)872-9311 for after finals.



ANA FORTUNA
PRIMARY EXAMINER

Ana Fortuna

June 7, 2002